

The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANTHONY ROBIN WHITE

Appeal No. 2007-0186  
Application No. 09/939,491

ORDER UNDER 37 CFR § 41.50(d)

MAILED

FEB 28 2007

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before SCHEINER, ADAMS and GRIMES, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

ORDER UNDER 37 CFR § 41.50(d)

This appeal involves plant patent Application No. 09/939,491, filed August 24, 2001. The issue raised in this appeal is whether evidence of foreign sales of the claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing the plant, thereby creating a bar under 35 U.S.C. § 102(b).

Claim 1, the only claim on appeal, is reproduced below:

1. A new and distinct variety of Clematis plant named 'Avalanche' as described and illustrated.

Procedural History

On April 7, 2003 appellant filed a Brief appealing the final rejection of claim 1<sup>1</sup> under 35 U.S.C. § 102(b) as being unpatentable over Plant Breeder's Rights grant no. 4711 in view of public sales in the United Kingdom. See Brief, filed April 7, 2003, page 2. On January 10, 2005 the Merits Panel entered its Decision ('05 Decision) vacating the rejection of record and remanding the application to the Examiner for further consideration. The Merits Panel stated, "[t]he question raised in this appeal involves whether evidence of foreign sales of the claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing the plant, thereby creating a bar under 35 U.S.C. § 102(b)." '05 Decision, page 1. The Merits Panel explained, "[t]he Court of Appeals for the Federal Circuit considered that issue in In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004), and held in the affirmative." Id. The Merits Panel noted, however, that the Elsner

court stated that "[t]he foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art." Id. at 1131, 72 USPQ2d at 1043. The court also stated that the record did not establish that "even if the interested public would readily know of the foreign sales, those sales enabled one of ordinary skill in the art to reproduce the claimed plants without undue experimentation." Id.

'05 Decision, bridging paragraph, pages 1-2.

In explaining the facts of record, the Merits Panel found ('05 Decision, page 2) that the Examiner

is relying upon applicant's admission that the claimed plant "was sold in the United Kingdom in the fall of 1998" as evidence that "European Community Plant Breeder's Rights grant no. 4711" is

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<sup>1</sup> Claim 1 of this appeal is the same as claim 1 now before this panel.

enabled. Examiner's Answer, page 2. However, there is no evidence whether the sales were of the type that would be noticed by those of skill in the art. Nor has the other issue raised by the Federal Circuit in Elsner, whether the sales would enable one skilled in the art to reproduce the claimed plant without undue experimentation, been addressed.

Accordingly, the rejection of record was vacated and the application was remanded "to the [E]xaminer to determine whether the sales of the claimed plant (1) were 'an obscure, solitary occurrence that would go unnoticed by those skilled in the art' and (2) would enable one to reproduce the plant without undue experimentation." '05 Decision, bridging paragraph, pages 2-3.

In response, the Examiner issued a communication to Appellant under 37 CFR § 1.105, citing "the recent" Elsner decision and "requesting information regarding the clematis plant 'Avalanche'." See Paper, mailed April 15, 2005, page 1. Specifically, the Examiner required Appellant to provide:

- a) a copy of any plant breeder's rights applications, published proposed denominations, and breeder's rights grants, relating to the claimed plant variety;
- b) a copy of any publications or advertisements relating to sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world if the sale, offer for sale, or public distribution occurred prior to the filing date of this application; [and]
- c) any public information available regarding sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world that occurred prior to the filing date of this application, including the date(s) and location(s)

Id.

In response, Appellant submitted a copy of "the European Plant Breeder['s] Rights application, proposed denomination and grant . . ."; and "[a] copy of a press release from The Guernsey Clemantis Nursery Limited"

announcing "the launch of the plant to be in the spring of 1999". See Paper, received Jun 7, 2005. In addition, Appellant explained that

Clematis Avalanche was distributed under an exclusive license with The Guernsey Clematis Nursery Limited in the United Kingdom for a 3 year period. In the fall of 1998, the entire stock of Clematis 'Avalanche' at The Guernsey Clematis Nursery Limited was sold to Dailey Nurseries in the United Kingdom as potted liners. All of these plants were grown out at Dailey Nurseries in the United Kingdom and first sold to the public in the spring of 1999.

Id., page 2.

Upon receipt of this information, the Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Plant Breeder's Right grant no. 4711 (European Community). In support of this rejection the Examiner directs attention to "Applicant's admission that 'Avalanche' was sold in the United Kingdom the fall of 1998 (page 3, of reply filed September 17, 2002 and response to the request for information dated June 7, 2005)." Final Rejection, mailed October 7, 2005, page 2.

According to the Examiner the Plant Breeder's Right grant no. 4711 is a publication that "is enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation." Final Rejection, bridging paragraph, pages 3-4. Regarding "the notoriety of various methods of asexual propagation of clematis", the Examiner directs attention to "an article reproduced from the 1998 International Clematis Society Journal", and notes that "one could obtain

additional information from the website

[www.http://dspace.dial.pipex.com/clematis/prop.htm](http://dspace.dial.pipex.com/clematis/prop.htm)." Final Rejection, page 4.

According to the Examiner, the foreign sale is not obscure because "[o]ne of ordinary skill in the art would have known where to obtain the claimed plant and request information. With the contact information, one of ordinary skill in the art could check the availability of the claimed plant and where to purchase the plant." Final Rejection, page 4.

Appellant's appeal of this rejection is now before this Merits Panel. Under the provisions of 37 CFR § 41.50(d),<sup>2</sup> we require Appellant to address the following matters:

I. The public use and availability of a plant variety outside of the United States:

Appellant asserts that "[t]he public use and availability of the subject plant variety outside of the United States is not material to a determination of 'plant patentability' of a plant variety in the United States under [§] 102[("b")]." Brief, page 10. This assertion is inconsistent with the conclusion in Elsner, 381 F.3d at 1126, 72 USPQ2d at 1039-1040 that "published Plant Breeder's Rights applications . . . coupled with foreign sales of the plants may constitute a [§] 102(b) bar to patentability."

As the Elsner court explains, "the precise focus of the analysis is not whether the foreign sales are themselves § 102(b) prior art, but whether the publication has placed the claimed invention in the possession of the public

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<sup>2</sup> "The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such an order." 37 CFR § 41.50(d).

before the critical date. Thus, foreign sales of the claimed plants may be within the knowledge of the skilled artisan and may be considered to provide the public with access to Appellants' inventions." Elsner, 381 F.3d at 1130, 72 USPQ2d at 1042.

Accordingly, we require Appellant to:

1. clearly state the rule of law which supports Appellant's position that, in contrast to the holding in Elsner, the public use and availability of a plant variety outside of the United States is not material to a determination of the patentability of a plant variety in the United States under 35 U.S.C. § 102(b); and
2. clearly explain the basis for the position taken in part 1.

## II. LeGrice:

Appellant asserts (Brief, page 12), "[t]he court in In re LeGrice established a perfectly workable and rational approach for applying the policy and the language of [§] 102(b) to this unique situation." Appellant does not, however, address Elsner.

The Elsner court found that their holding did not conflict with LeGrice which

decided only the narrow issue whether a printed publication of a plant patent that is not enabled is a statutory bar. That decision did not address the manner in which a publication may be enabled, and it did not decide whether other evidence such as the availability of an invention through foreign sales may be considered in determining whether a printed publication enables a skilled artisan to reproduce a claimed plant. In fact, there was no mention of sales in the LeGrice opinion. We therefore conclude that LeGrice left that issue open, and our decision today is not inconsistent with LeGrice.

Elsner, 381 F.3d at 1130, 72 USPQ2d at 1042-43.

Accordingly, we require Appellant to:

1. clearly state whether it is, or is not Appellant's position that Elsner is in conflict with LeGrice; and
2. clearly explain the basis for the position taken in part 1.

**III. Importation of foreign nursery stock into the United States:**

Appellant asserts that "a new plant variety cannot be anticipated without direct access by the American public in the United States to the new plant or its asexually reproduced progeny." Brief, page 13. Appellant asserts that "[f]oreign asexually propagatable plant material, unlike the information in a printed publication, is not freely accessible to the American public on an unregulated basis." Brief, page 12. Appellant asserts that "[t]he Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States . . . [and] imposes rigorous importation requirements." Id.

Accordingly, we require Appellant to:

1. clearly explain how the evidence on this record establishes that United States importation requirements would have precluded a person of ordinary skill in the art from obtaining a foreign asexually propagatable clematis plant material, as claimed.

**IV. The 1998 sale of the claimed plant in the United Kingdom:**

The Examiner relies upon Appellant's admission that the claimed plant was sold in the United Kingdom in the fall of 1998. Accordingly, we require Appellant to clearly explain:

1. how the evidence on this record establishes that the admitted sale of the claimed plant should be considered "an obscure

solitary occurrence that would go unnoticed by those skilled in the art." Cf. Elsner, 381 F.3d at 1131, 72 USPQ2d at 1043; and

2. how the evidence on this record establishes that a person of ordinary skill in the art who purchased the plant in 1998 would not be able to reproduce the claimed plant without undue experimentation. Cf. Elsner, 381 F.3d at 1131, 72 USPQ2d at 1044.

### **CONCLUSION**

In conclusion, we require Appellant to address the foregoing matters

We caution, however, that Appellant's response is to be limited to the matters outlined above. When necessary, Appellant may direct attention to evidence that is of record in this application. This is not, however, an invitation to introduce new evidence into the record.

## **TIME PERIOD FOR RESPONSE**

A period of one month from the date of this order is set for Appellant's response. This time is non-extendable.

**Failure to respond in a timely manner will result in dismissal of the appeal**

37 CFR § 41.50(d)

*Toni R. Scheiner*  
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Administrative Patent Judge )  
  
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